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Hyun-kwon Chung

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EXAMINER

PRICE, NATHAN E

ART UNIT

PAPER NUMBER

2194

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

INFORMATION REQUIREMENT

Requirement For Information - 37 C.F.R. § 1.105

I. Applicant and Assignee of this application are required under 37 C.F.R. 1.105 to provide the following that the Examiner has determined is reasonably necessary to the examination of this application.

This request is made in view of the prosecution history with arguments made by Applicant and will assist in determining whether certain references and technologies constitute prior art against specific claims. Examiner is not certain whether enhanced navigation (ENAV) may constitute prior art based upon the amendments into the specification and claims in Applicant's response filed 5 September 2007.

To make the record clear the examiner is requiring specific information that may be used to delineate the invention and features of enhanced navigation (ENAV) that were publicly known before Applicant's first filing of a disclosure including these features.

Examiner rejected claims 23 and 24 under 35 U.S.C. 112, second paragraph, in the Office Action mailed 6 June 2007 because it was not clear if Applicant's use of the term ENAV meant the same thing as enhanced navigation despite the specification and claims indicating that ENAV meant enhanced audio video. In Applicant's response filed 5 September 2007, the specification and claims were amended to indicate that ENAV

Art Unit: 2194

meant enhanced navigation instead of enhanced audio video. Applicant's remarks state the amendments were made based on the Examiner's position (see page 20 ¶ 1 of REMARKS filed 5 September 2007). Examiner's position is that it is not clear if Applicant's use of enhanced audio video (ENAV) in Applicant's original disclosure refers to the same technology as enhanced navigation (ENAV). If the two are not the same, then the amendments filed 5 September 2007 may constitute new matter. Applicant's response did not clarify whether or not enhanced audio video (ENAV) in Applicant's original disclosure refers to the same technology as enhanced navigation (ENAV). Instead, Applicant's response merely indicated the amendments were made based on the Examiner's position.

Additionally, Examiner's search has uncovered references that suggest the DVD Forum was, at the time the references were created, developing enhanced navigation (ENAV). See PTO-892 mailed with this Office Action. Specifically, see Bush et al. page 5 ¶ 1 and "eDVD ADVANCED INTERACTIVITY & INTERNET CONNECTIVITY" last 2 paragraphs. However, Examiner has been unable to find sufficient documentation to determine what features, if any, of enhanced navigation (ENAV) constitutes prior art with respect to Applicant's disclosure and priority dates.

As these are needed to provide a complete examination of the pending application it is proper to require disclosure of the following. See M.P.E.P. 704.11 and 37 C.F.R. 1.105(a)(i)-(vii).

In response to this requirement, please provide:

A. A translation in the English language of each foreign application to which Applicant claims priority that is not in the English language and discloses ENAV, regardless of the meaning of ENAV in the foreign application. See 37 C.F.R. 1.55(a)(4).

B. Stipulate, for Applicant's original disclosure and for each foreign application to which Applicant claims priority and discloses ENAV, whether enhanced audio video (ENAV) refers to the same technology as enhanced navigation (ENAV).

1. If enhanced audio video (ENAV) does refer to the same technology as enhanced navigation (ENAV) for Applicant's original disclosure or any of the foreign applications to which Applicant claims priority and discloses ENAV:

a. Provide a copy of any publicly available documents and date of first publication of each document pertaining to the development of enhanced navigation (ENAV) including, but not limited to, specifications, standards, drafts, proposals, reviews/comments, requests for proposals, and requests for comments of which Applicant is aware regardless of date.

b. Provide a copy of any publicly available documents and date of first publication of each document pertaining to enhanced navigation (ENAV) including, but not limited to, specifications, standards, drafts, proposals, reviews/comments, requests for proposals, and requests for comments of which Applicant is aware and has a publication date that may qualify as prior art under 35 U.S.C. 102 or 103.

c. Provide a copy of any non-patent literature, published applications, or patent (US or Foreign) *used in drafting the instant application, whether cited or not* in the IDS submission(s) dated 01/20/2004 or 06/17/2004.

d. Provide a copy of any non-patent literature, published application, or patent (US or Foreign) that was *used in the inventive process to accomplish the applicant's inventive results*.

e. Provide the date of first use of the claimed invention, known to by any of the inventors or Applicant, at the time the application was filed *notwithstanding* the date of use.

f. Any written descriptions or analyses, prepared by any of the inventors or assignees, of goods or services in competition with the goods or

Art Unit: 2194

services the *claimed* subject matter or enhanced navigation (ENAV) has been embodied in.

This request is made in view of the prosecution history with arguments made by Applicant with prior art provided and will assist in determining whether uncovered references and commercially available products might constitute prior art against specific claims pending in the application.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 C.F.R. 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.

The fee and certification requirements of 37 C.F.R. 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. 1.105 are subject to the fee and certification requirements of 37 C.F.R. 1.97.

In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met

Art Unit: 2194

by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

This requirement is subject to the provisions of 37 C.F.R. 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 C.F.R. 1.136(a).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Price whose telephone number is (571) 272-4196. The examiner can normally be reached on 6:00am - 2:30pm, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Thomson can be reached on (571) 272-3718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2194

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NP


WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER